

### REMARKS

Applicants file this RCE in order to hold an interview with the Examiner on this case at the earliest convenience of the Examiner.

New claim 55 is fully supported by the data in Figure 2.

Applicants have reviewed the Examiner's comments in the Advisory Action of April 3, 2007, and respectively submit that the Examiner has failed to consider the limitation "wherein the metallic colloid has a Raman signal that is greater than that of a silver colloid prepared by a titration method wherein a *boiling silver nitrate* solution is titrated with a sodium citrate solution to produce the silver colloid" in claim 1. Paragraph [0018] of the specification clarifies that "[t]he methods of producing metallic colloids described herein are in contrast to prior methods wherein a *boiling silver nitrate* is titrated with a sodium citrate solution."

The Examiner states in the Advisory that "McCormick teaches the organic molecule of the instant specification and the combination of Kidwell and McCormick teach the molecule attached to the metallic colloid particle. Therefore, the enhancement property is inherent to the colloid *produced by the combination of references*." [Emphasis added.]

In the pending case, the Examiner is assuming that "wherein the metallic colloid has a Raman signal that is greater than that of a silver colloid prepared by a titration method wherein a boiling silver nitrate solution is titrated with a sodium citrate solution to produce the silver colloid" is somehow "inherent" in a hypothetical embodiment arrived at by combining Kidwell and McCormick. However, "[o]bviousness cannot be predicated on what is not known at the time of an invention is made, even if the inherency of a certain feature is later established." *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). The Board in *Rijckaert* did the same what the Examiner is doing, and the Federal Circuit reversed:

The Board concluded that the subject matter of the claims would have been obvious over Awamoto in view of Driessen, stating that "the time expansion or time compression relationship is satisfied for the







metallic colloid has a Raman signal that is greater than that of a silver colloid prepared by a titration method wherein a boiling silver nitrate solution is titrated with a sodium citrate solution to produce the silver colloid" in claim" is somehow "inherent" in a hypothetical embodiment arrived by combining elements of the prior art. This argument of the Examiner amounts to a *retrospective view of inherency*, which not a legal basis to assert inherency, as explained in *In re Newell*.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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